

Notice of Allowability

Application No.

10/551,522

Examiner

Yong Chu

Applicant(s)

LUXEMBOURG ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 05/10/2007.
2. ☒ The allowed claim(s) is/are 30,34-37, and 65-67 (renumbered as 1-8).
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

Claim 33 was cancelled by the amendment filed on 05/10/2007. Claims 65-67 are new by the Amendment. Claims 1-32, and 34-67 are pending in this application.

Response to Amendment

The Amendment by Applicants' representative Martin D. Moynihan dated on 05/10/2007 has been entered.

Response to Remarks

The Amendment with change of formula I in claim 30 has been entered. There is no new matter introduced, because the error of missing "-O-" between -N and -P in formula I is an obvious error to one skilled in the art, which is further supported by Claim 38 with -O- presence.

Status of the Claims

Claims 1-29, and 38-64 are non-elected subject matters. Claims 30-32, 34-37, and 65-67 are to be examined on the merits.

Claim Objection

Recitation of an intended to use or utility in the preamble which can otherwise stand-alone is not considered a further limitation of the claim and therefore cannot impart patentability to a known composition of matter. See, *in re Spada*, 15 USPQ.2d 1655 (Fed. Cir. 1990).

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Claims 31 and 32 are objected to under 37CFR 1.75 as being a substantial duplicate of claim 30 for intend to use the claimed compound as coupling agent for peptide synthesis, which does not add weight in patent scope. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

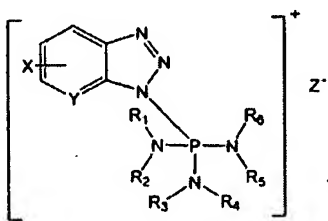
Examiner's amendment

An examiner's amendment to the record with authorization by Applicant's representative Martin D. Moynihan on 07/16/2007 appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

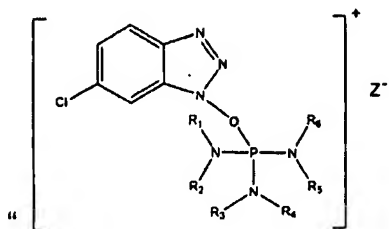
The application has been amended as follows:

Delete Claims 1-29, 31-32, and 38-64.

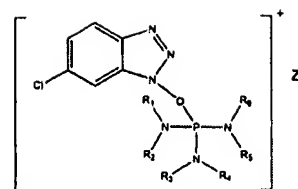
Amend title as: "Benzotriazole-1-yl-N-oxy-phosphonium coupling agent."

Replace Formula I  , line 1 on page 9; and line 10 on page 31 with

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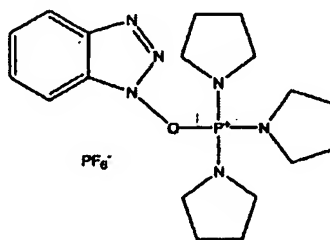


Reasons for Allowance



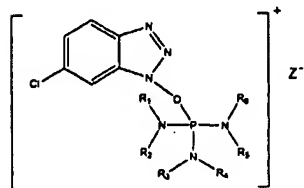
The present invention is directed to a compound of formula I

The closest prior art of record is cited in the Specification by Coste *et al.*, *Tetrahedron Letters*, Vol. 31, (1975), p205.



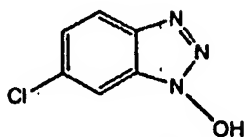
benzotriazole-1-yl-oxy-tris-pyrrolidino-phosphonium hexafluorophosphate (PyBOP)

Coste *et al.* disclosed a compound having the same utility as the instantly claimed compound as a peptide-coupling reagent. This compound is *prima facie* obvious over the instantly claimed compound of



in view of another peptide-coupling compound

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1-hydroxy-6-chlorobenzotriazole (Cl-HOBT)

However, Applicant disclosed the **advantage** of the instantly claimed compound as peptide coupling agent over the reference compound PyBOP in the original disclosure of tables 3, 4 and 5, page 37-39, with side-by-side comparison data. When applicant urges patentability of some advantage over a reference, that advantage should be disclosed in the specification. *In re Rossi*, 241 F.2d 726, 112 U.S.P.Q 479 (CCPA 1956).

The prior art reference by Vendrell *et al.*, *Tetrahedron Letter* 46 (2005), p5383-5386 is overcome by the Declaration under 37CFR 1.132 filed on 03/20/2007.

Therefore, Claims 30, 34-37, and 65-67 are allowed.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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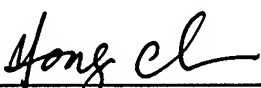
published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

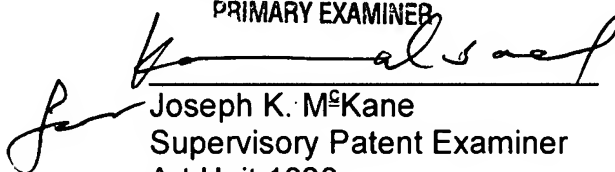
Business Center (EBC) at 866-217-9197 (toll-free).



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KAMAL A. SAEED, PH.D.

PRIMARY EXAMINER



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